

## REMARKS

This application has been reviewed in light of the Office Action dated December 12, 2006. Claims 29, 31, 32, 34-36, and 38-42 are presented for examination, of which Claims 29, 35, 36, 40, 41, and 42 are in independent form. Claims 29, 32, 34-36, and 38-42 have been amended to define Applicants' invention more clearly. Favorable reconsideration is requested.

An Information Disclosure Statement and a corresponding PTO-1449 form were submitted on December 6, 2005, February 3, 2006, and August 11, 2006 as evidenced by the copies downloaded and printed from the PAIR system bearing the stamp of the U.S. Patent and Trademark Office, a copy of which is attached hereto. An Information Disclosure Statement and a corresponding PTO-1449 form was submitted on December 18, 2006 as evidenced by an Electronic Filing Receipt indicating confirmation number 4944, a copy of which is attached hereto. Applicants respectfully request the Examiner to return an initialed copy of each PTO-1449 form, indicating that the references listed thereon have been considered and made of record in the present application.

Claims 36 and 42 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants disagree and respectfully traverse the rejection for the following reasons.

M.P.E.P. §2106.01(I) states, in part:

“Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical

structure, such as a computer memory, USPTO personnel should treat the claim as a product claim. See paragraph IV.B.2(a), below.” [Emphasis added].

Applicants submit that Claims 36 and 42 are directed to statutory subject matter, and accordingly, respectfully request that the rejection under 35 U.S.C. §101 be withdrawn.

Claims 29, 32, 34, 35, and 38-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,098,065 (*Skillen et al.*), in view of U.S. Patent App. Pub. No. 2004/0030656 A1 (*Kambayashi et al.*) and of U.S. Patent No. 6,522,421 (*Chapman et al.*) Applicants submit that independent Claims 29, 35, 36, 40, 41, and 42, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

The aspect of the present invention set forth in Claim 29 is an information provider system comprising a server terminal, a client communication terminal, and a printer apparatus. The server terminal has a storage unit adapted to store content information corresponding to an identification code, and a provision unit adapted to provide the client communication terminal with message information including the identification code. The client communication terminal has (1) an extraction unit adapted to extract the identification code from the message information provided by the provision unit, (2) a transmission unit adapted to transmit the identification code extracted by the extraction unit to a printer apparatus, which forwards the identification code to the server terminal, and (3) an instruction unit adapted to instruct both the extraction unit to execute the extraction process and the transmission unit to execute the transmission process in response to one operation by using a single physical button. The printer apparatus, which is connected to the server terminal, has (4) a reception unit adapted to receive, from the server terminal, the content information corresponding to the identification

code, which has been transmitted from the client communication terminal, and (5) a printing unit adapted to print the content information received by the reception unit.

Among other notable features of Claim 29 are the provision unit of the server terminal, the client communication terminal, and the printer apparatus. The provision unit can “provide a client communication terminal with message information including the identification code.” The client communication terminal can “extract an identification code from the message information provided by the provision unit,” (i.e. the server terminal) and “transmit the identification code extracted by the extraction unit to a printer apparatus.” The printer apparatus “forwards the identification code to the server terminal.” The extraction unit and the transmission unit are both instructed by an instruction unit to start their respective processes in response to one operation by using a single physical button (i.e. a button of the client communication terminal). The printer apparatus receives, from the server terminal, the content information corresponding to the identification code, which has been transmitted from the client communication terminal and prints the content information received.

Applicants submit that a combination of *Skillen*, *Kambayashi*, and *Chapman* assuming such combination would even be permissible, would fail to teach or suggest the above-mentioned features of the system of Claim 29.

*Skillen*, as understood by Applicants, relates to an associative search engine. Apparently, *Skillen* provides a method of searching advertisement information (using the associative search engine 40) on the basis of a user profile (user ID, purchase trend, prior search argument or the like), which provides a user with user-desired information (based on the user’s inputted search argument) together with the searched advertisement information (a separate search of advertisement information where the associative search engine uses user profile

information). The searched advertisement information provided is generated as a result of a separate search by an associative search engine that may use user profile information to search for advertisement information that the associative search engine deems relevant for the user. When the user clicks the provided advertisement information that is part of the search results, a system navigates the user to an Internet site of the owner of the advertisement information, and extracts a fee for the navigation from the user's account.

Apparently the *Skillen* method provides for two search engines in communication with each other. The first search engine receives a search argument from a user, performs a search based on the argument, and passes the argument and search results to the second search engine (the associative search engine). As Applicants understand *Skillen*, the search argument passed from the user to the search engines is not an identification code corresponding to content information. Additionally, the information used by the associative search engine to generate the advertisement information may be user profile information associated with the user. As Applicants understand *Skillen*, this user profile information identifies or corresponds to the user, but does not identify specific content information. This user profile information in *Skillen* does not appear to Applicants to suggest an identification code like that forwarded by the printer apparatus of Claim 29, which identifies the content information.

Furthermore, in *Skillen*, a search argument is sent from a user terminal to the search engines and information is sent back to the user terminal based upon the user's profile and the user's inputted search argument. However, as stated above, in the system of Claim 29, the only information transmitted between the client terminal and the printer apparatus is an identification code corresponding to content information. In the system of Claim 29, content

information corresponding to an identification code is not sent back to the client terminal, but instead is received by the printer apparatus.

Nothing has been found in *Skillen* that is believed to teach or suggest the above-mentioned features of the client communication terminal and the printer apparatus of Claim 29.

*Kambayashi*, as understood by Applicants, relates to a content reproduce apparatus for acquiring an encrypted digital content and decrypting and outputting it with a key from digital license information.

Therefore, nothing has been found in *Kambayashi* that is believed to teach or suggest an (1) extraction unit adapted to extract the identification code from the message information provided by the provision unit; (2) a transmission unit adapted to transmit the identification code extracted by the extraction unit to a printer apparatus, which forwards the identification code to the server terminal; and (3) an instruction unit adapted to instruct both the extraction unit to execute the extraction process and the transmission unit to execute the transmission process in response to one operation by using a single physical button.

*Chapman* relates to a network printing system that provides print job status via email. As Applicants understand the *Chapman* system a network printer receives an application file that contains embedded e-mail information and prints the application file. This is different from the system of Claim 29. First, the email information embedded in the email does not identify or correspond to the content information of the application file. On the contrary, the embedded e-mail information in *Chapman* is used to identify recipients of status information about the print job. Thus, the information serves no purpose of identifying the content information, but merely functions to identify recipients of print status. Second, the printer receives an application file (content information) along with additional embedded information,

whereas in Claim 29, the printer apparatus receives, from the server terminal, the content information corresponding to the identification code, which has been transmitted separately from the client communication terminal.

Nothing has been found in *Chapman* that is believed to teach or suggest (1) a transmission unit adapted to transmit the identification code extracted by the extraction unit to a printer apparatus, which forwards the identification code to the server terminal; and (2) the printer apparatus, which is connected to the server terminal, the printer apparatus having: a reception unit adapted to receive, from the server terminal, the content information corresponding to the identification code, which has been transmitted from the client communication terminal; and a printing unit adapted to print the content information received by the reception unit.

Accordingly, even if *Kambayashi* and *Skillen* are combined as proposed in the Office Action, and even assuming that that combination would be proper, the result would still lack several features of Claim 29. Applicants submit therefore that Claim 29 is patentable over the cited art.

Independent Claims 35, 36, 40, 41, and 42 each include features similar to those discussed above with respect to Claim 29, and those claims also are believed to be patentable for similar reasons.

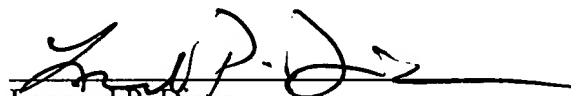
The other rejected claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Because each dependent claim also is deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place the present application in condition for allowance. Therefore, entry of this Amendment under 37 C.F.R. §1.116 is believed proper and is respectfully requested, as an earnest effort to advance prosecution and reduce the number of issues. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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